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| 09/245,101      | 01/21/1999  | MARK H. KRAML        | 5                   | 4519             |

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EXAMINER

BANGACHON, WILLIAM L

ART UNIT PAPER NUMBER

2635

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/245,101             | KRAML, MARK H.      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | William Bangachon      | 2635                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☒ Claim(s) 1-57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2003 and 21 January 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) ☒ The proposed drawing correction filed on 17 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## DETAILED ACTION

### *Examiner's Response*

1. This Office Action is in response to the amendment filed 17 January 2003 and is believed to be fully responsive to the arguments presented. The presentation of claims in view of the arguments and the present state of the prior art were considered. The Examiner respectfully traverses Applicant's arguments. It is the Examiner's position that claims 1-57 stands unpatentable for the reasons set forth in this Office action:

### *Response to Arguments*

2. Applicant's arguments with respect to claims 1-57 have been considered but are moot in view of the new ground(s) of rejection. Further, applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that the prior art made of record (Moughanni) "does not disclose a remotely located **computer-controlled** device that performs at least **two actions** based on a specific command included in a paging message as claimed in independent claims 1, 28 and 57" {page 14, 2<sup>nd</sup> paragraph}. Further, the applicant argues that the system of Moughanni is merely an electro-mechanical device (page 14, lines 8-9).

The examiner respectfully traverses applicant's arguments in that, Moughanni teaches of a computer/data processing system (20) comprising a central processing unit/CPU (28), command processing unit (34), and other parts that clearly suggests a

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computer {col. 3, lines 3-10}. The computer/data processing system (20) controls the device (50) such as thermostats, cars, televisions, and almost all household appliances, which use electronic circuits for control. The remotely located computer (20) controlled device (50) performs at least two actions (first and second action) based on specific commands such as turning on the heater or air conditioner (first action/command) and specify a temperature (second action/command) or enable a video recorder (first action) and program the recorder (second action) {col.2, lines 49-60}. The heater may be in a car or a home {col. 2, lines 60-63}. If the heater was in a car, then clearly, the car must first be started, the heater turned on, and finally, the temperature specified, which amounts to at least three actions. Therefore, rejection to claims 1-57 is maintained in this Office action.

### ***Drawings***

3. The corrected or substitute drawings received in response to the drawing objections in the last Office action are approved.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **computer-controlled device** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The “**remotely located computer-controlled device**” is not disclosed in the specification.

***Claim Rejections - 35 USC § 112***

6. Claims 1-57 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The “remotely located computer-controlled device” was not originally disclosed in the specification.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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11. Claims 1-11 and 28-37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 5,608,655 (Moughanni et al) in view of applicant's arguments (page 14, lines 6-8).

In claim 1, Moughanni et al teach of a system (10) for operation of a remotely located computer-controlled (20) device (50) {see whole document} comprising,

receiver means (12) for receiving at least one paging messages {col. 1, lines 48-62; col. 3, lines 42-55}, said receiver means being co-located with said remotely located computer-controlled (20) device (50) as shown in figure 1.

means for comparing content data of said at least one paging messages to a set of allowed commands (28) {col. 4, lines 42-67}; and

means for sending a specific command to said remotely located device, said specific command being determined based on a match found between said received paging message contents and one of said allowed commands (34) {col. 5, lines 1-54}.

wherein said remotely located computer-controlled device performs at least two actions based on said specific command such as turning on the heater or air conditioner (first action/command) and specify a temperature (second action/command) or enable a video recorder (first action) and program the recorder (second action) {col.2, lines 49-60}. The heater may be in a car or a home {col. 2, lines 60-63}.

Alternatively, If the heater was in a car, then clearly, the car must first be started (first action), the heater turned on (second action), and finally, the temperature specified (third action), which amounts to at least three actions. This is in contrast to applicant's

argument (page 14, lines 8-9) that the device (50) is an electro-mechanical device since there are at least three actions performed. And since the device (50) is capable of performing more than a single action in response to a request as argued by applicant (page 14, lines 6-8), then the device (50) is obviously a computer-controlled device, to one of ordinary skill in the art. Therefore, it would have been obvious that the device (50) is a computer-controlled device, as argued by applicant, because the device (50) is capable of performing at least three actions, to one of ordinary skill in the art.

In claim 2, the system (10) of claim 1, further comprising buffer means (24 or 30) for receiving said at least one paging message from said receiver means {col. 4, lines 33-43}.

In claims 3 and 4, said means for sending (34) further comprises command generation means (36) for constructing said specific command to be forwarded to said remotely located computer-controlled (20) device {col. 5, lines 46-54}.

In claims 5 and 6, said specific command is a trigger signal {col. 5, lines 55-col. 6, line 20}.

In claims 7 and 8, said specific command is a command string as shown in figure 4 {col. 4, lines 28-33}.



In claims 9 and 10, said message contents includes more than one of said allowed commands {col. 4, lines 54-67; col. 5, lines 50-53; col. 6, lines 15-18}.

Claims 28-37 recites a method of using the system of claims 1-10 and therefore rejected for the same reasons.

12. Claims 11-27 and 38-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,608,655 (Moughanni et al) in view of US 5,588,038 (Snyder).

In claims 11, 21 and 23, Moughanni et al does not disclose a response means for sending a response paging message/indication of the status of said remotely located device. However, these claim limitations are conventional in paging systems, as evidenced by Snyder, and would have been obvious in the system of Moughanni et al, to one of ordinary skill in the art.

Snyder, in the same field of endeavor (remote control using paging devices), teach of a response means/transceiver (202) for sending a response paging message {see whole document}. This feature is beneficial because the owner of the controlled device can be provided with the status of the controlled device for personal use or that can be relayed to law enforcement agencies {Snyder, col. 2, lines 43-50; col. 10, lines 48-67}. Furthermore, the two-way pager (202) "can be used to send signals that are responsive to sensing various conditions and that request an action by the owner" {col. 10, lines 64-67}. Obviously, this feature is implementable and beneficial in the system

of Moughanni et al to one of ordinary skill in the art. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art, to have a response means for sending a response paging message in the system of Moughanni et al, as claimed in claim 11, because the owner of the controlled device can be provided with the status of the controlled device (50) for personal use or that can be relayed to law enforcement agencies, as evidenced by Snyder.

In claim 12, the system (10) of claim 11, further comprising buffer means (24 or 30) for receiving said paging message from said receiver means {col. 4, lines 33-43}.

In claims 13 and 14, said means for sending (34) further comprises command generation means (36) for constructing said specific command to be forwarded to said remotely located device {col. 5, lines 46-54}.

In claims 15 and 16, said specific command is a trigger signal {col. 5, lines 55-col. 6, line 20}.

In claims 17 and 18, said specific command is a command string as shown in figure 4 {col. 4, lines 28-33}.

In claims 9, 10, 19 and 20, said message contents includes more than one of said allowed commands {col. 4, lines 54-67; col. 5, lines 50-53; col. 6, lines 15-18}.

In claim 22, the system of claim 21, wherein said means for creating said paging response message includes sensing means for determining the state of said remotely located device {Snyder, col. 10, lines 51-67}.

In claim 24, the system of claim 11, wherein said response paging message includes a security challenge message {Snyder, col. 6, lines 26-30}.

In claims 25 and 26, obviously, said response-paging message/status of the controlled device includes an indication of the success or failure of the execution of at least one of said specific commands to one of ordinary skill in the art. Any status response by the controlled device would clearly be an indication of success or failure of the execution of specific commands.

In claim 27, clearly, said response paging message includes data collected by or from said remotely located device since the response includes the status of the controlled device.

Claims 38-54 recites a method of practicing the system of claims 11-27 and therefore rejected for the same reasons.

Claim 55 recites the claims limitations of claims 1-27 and therefore rejected for the same reasons.

In claims 56 and 57, Moughanni et al in view of Snyder does not disclose a period of time that is a variable component of said received paging message wherein said period of time is a predetermined minimum period of time for performance of said command by said remotely located device. However, these claim limitations are a matter of design choice in the control of a remotely located device and would have been obvious in the system of Moughanni et al to one of ordinary skill in the art.

Moughanni et al teach of "remotely controlling thermostats, cars, television, and almost all household appliances which use electronic circuits for control" {col. 2, lines 49-63}. Not only do Moughanni et al teach of turning on or off an appliance, but also teach of enabling and programming a thermostat and video recorder. By way of example, Moughanni et al teach of paging the thermostat of an owner's home by dialing in a first command to turn on the heater and dialing in a second command that specifies a temperature {lines 52-56}. Obviously, the thermostat can also be turned on and off at certain period of times. And obviously, the predetermined minimum period of time for performance of said command by any of the appliance/device as claimed, depends on what appliance/device is to be controlled. Further, the thermostat of an owners home may require to be turned on for several hours or the thermostat of an owners car may be turned on for several minutes. Therefore, at the time of the invention, it would have been a matter of design choice to have a predetermined minimum period of time for

performance of said command by any of the appliance/device in the system of Moughanni et al, to one of ordinary skill in the art.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,748,084 (Isikoff) is cited in that it teaches of a remotely located computer-controlled device. In this case, a laptop computer is the device {see whole document}.

***Examiner Contact Information***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314 for regular and After Final formal communications. The examiner's fax number is 703-746-6071 for informal communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

William L Bangachon  
Examiner  
Art Unit 2635

January 28, 2003

MICHAEL HORABIK  
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